



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

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:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to question 38 of the morning section and questions 35 and 45 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On February 3, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 38 and afternoon questions 35 and 45. Petitioner's arguments for these questions are addressed individually below.

Morning question 38 reads as follows:

38. Registered practitioner Roni files a utility patent application under 37 CFR 1.53(b) in the USPTO having one claim on May 6, 1998. A proper final rejection of claim 1 was mailed on June 28, 2000. Roni files a request for continued examination with the appropriate fee on September 12, 2000, and submits an amendment to claim 1 with the request. On October 7, 2000, Roni learns about a publication (the "Columbus reference") which she knows to be material to patentability of claim 1, but which was not considered by the examiner during prosecution of the application. Roni prepares an information disclosure statement that complies with the provisions of 37 CFR 1.98, listing the Columbus reference. The finality of the action on June 28, 2000, is withdrawn in an Office action on November 20, 2000, which is after the filing of the request for continued examination. Which of the following actions, if taken by Roni, will properly result in the Columbus reference being considered by the Office during the pendency of the application?

(A) Filing the information disclosure statement on November 15, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).

(B) Filing the information disclosure statement on December 11, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).

(C) Filing the information disclosure statement on December 13, 2000, without any further statement and without the fee set forth in 37 CFR 1.17(p).

(D) (A) or (B) above.

(E) None of the above.

The model answer is selection (A).

(A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.” See 37 CFR 1.97(b)(4) and (c), effective date November 7, 2000; see also, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54630 (September 8, 2000); and 37 CFR 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092 (Aug. 16, 2000); MPEP § 609, paragraph III B(1)(c) (pg. 600-125) (8th Ed.). In addition, the Office withdraws the finality of the previous Office action and enters any submission upon verifying that the RCE was filed in compliance with § 1.114. See MPEP § 706.07(h), paragraphs III and V. As stated in 65 FR 54630, column 2, “[a]s the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination”; MPEP § 609, paragraph III.B (1)(b) (pg. 600-125) (8th Ed.). Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR 1.97(c). (E) is incorrect since (A) is correct.

The petitioner argues that answer (E) is the most correct. The petitioner contends that since the finality of the previous Office action was not removed until the Office action mailed on November 20, 2000, all possible actions taken by Roni must have occurred after November 20, 2000. Therefore, answer (E) is the most correct because, as the petitioner explains, answer (A) is incorrect.

The petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that Roni’s actions must have been taken after November 20, 2000, 37 CFR 1.97(b)(4) requires Roni to take action prior to the mailing of the Office action on November 20, 2000 if the IDS is to be considered without a statement specified in § 1.97(e) or the fee set forth in § 1.17(p). In addition, the Office will withdraw the finality of the previous Office action once the Office verifies that the RCE was timely filed with the fee set forth in 37 CFR 1.17(e) and a submission. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph V. Accordingly, answer (A) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 35 reads as follows:

35. Tony, a client, comes to you with regard to a competitor's two published patent applications, A and B, which were published one month ago. Tony shows you several material prior art publications and patents that he discovered for the first time while cleaning out his brother-in-law's attic last week. Assume no Notice of Allowance has been mailed in application A and a Notice of Allowance has been mailed in application B. Tony wants to know if it is too late to submit the information to the USPTO for consideration by the examiner. He also wants to know how it is accomplished, if the applicant needs to be served a copy, whether a fee is required and whether an explanation is needed for each reference. Which of the following is not accurate with respect to proper USPTO procedure?

(A) The submission by Tony of patents or publications relevant to pending published application A will be permitted without the necessity of paying the processing or petition fee required by 37 CFR 1.17(i) if the patents or publications are submitted within two months of the publication of the competitor's application.

(B) Each submission must identify the application to which it is directed by application number and include:

- (1) the appropriate fee set forth in 37 CFR 1.17(p);
- (2) a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;
- (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and
- (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(C) The submissions by Tony of patents or publications relevant to both of the pending published applications A and B need not be served upon the applicant.

(D) The submissions by Tony of patents or publications relevant to the pending published applications A and B shall not include any explanation of the patents or publications, or any other information.

(E) The submission by Tony of patents or publications relevant to pending published application B will be permitted only if accompanied by the processing fee as set forth in 37 CFR 1.17(i).

The model answer is selection (C).

Answer (C) does not reflect proper USPTO procedure because 37 CFR 1.99(c) requires service on the applicant and provides "[t]he submission under this section must be served

upon the applicant in accordance with § 1.248.” Answer (A) reflects proper USPTO procedure because it contains all of the elements of 37 CFR 1.99(a). Answer (B) reflects proper USPTO procedure because it contains all of the elements of 37 CFR 1.99(b). Answer (D) reflects proper USPTO procedure because it contains all of the elements of 37 CFR 1.99(d). Answer (E) reflects proper USPTO procedure because it contains all of the elements of 37 CFR 1.99(e).

The petitioner argues that answer (E) is the most correct because 37 CFR 1.99(e) is only applicable when submissions are filed after two months of the date of publication or prior to the notice of allowance. Since the petitioner states that neither of these two conditions have occurred, the petitioner contends that answer (E) is not accurate with respect to proper USPTO procedure.

Petitioner’s arguments have been fully considered, but are not persuasive. Petitioner states that a notice of allowance has not been mailed in her arguments. The question, however, clearly states “...a Notice of Allowance has been mailed in application B.” Given that a Notice of Allowance was already mailed in application B, answer (E) does apply to the fact pattern presented in the question and accurately reflect current USPTO procedure, and therefore, is not the best answer. Accordingly, answer (C) is the best answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 45 reads as follows:

45. You are prosecuting a patent application wherein an Office Action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The Examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office Action, you identify several errors in Figure 2 that also should be corrected. Assuming that you make a small amendment to the claims and develop persuasive arguments to overcome the obviousness rejection, and that the Examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner’s review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the Examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection (C).

(C) is the model answer selection because applicant submitted proposed drawing correction and explain the changes in a separate letter. See MPEP §§ 608.02(r) and 608.02(v). (A) is not the best answer because drawing changes normally must be approved by the Examiner before the application will be allowed. The Examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(v).

The petitioner argues that answer (A) is the best answer because it meets the requirements set forth in MPEP 608.02(r), and it addresses the factual situation in the question, according to the petitioner. The petitioner focuses on the statement in the question that "the Examiner will not object to your desired changes to Figure 2" Petitioner argues that since the Examiner will not object to the drawing changes that answer (A) is the most correct. Petitioner states that answer (B) is not the most correct as it does not address the facts presented in the question. The petitioner did correctly point out that the model answer did refer to the wrong section of the MPEP, e.g. MPEP 608.02(p) should have been MPEP 608.02(v). A change to the model answer will be made.

Petitioner's arguments have been fully considered, but are not persuasive. In the facts presented in the question, the examiner objected to Figure 1 because it failed to illustrate an item (see second sentence of the question). A substantive change to a figure must be shown in red ink in a proposed drawing change. See 37 CFR 1.121(d) and MPEP 608.02(v). While the Examiner will not object to the voluntary changes made to Figure 2, the Examiner must give his or her approval for the changes to both drawings, especially Figure 1, prior to the entry of the corrected drawings. Therefore, answer (A) is not the best answer because submitting corrected drawings, without a proposed drawing change, fails to comply with proper USPTO procedure.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy